

REMARKS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed March 18, 2009. With this paper, claims 33, 40, 41, and 48 have been amended. Support for the amendments may be found in the specification, claims and drawings as filed. For example, support may be found at page 6 line 24 through page 7 line 1 and page 23 line 26 through page 24 line 3. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

Telephone Interview

Applicants thank the Examiner for extending the courtesy of a telephone interview to Stephanie M. Clapper as their Representative on May 22, 2009. The interview generally pertained to a discussion centering around priority, as well as a brief discussion of possible claim amendments.

Claim Rejections under 35 U.S.C. § 102

On page 2 of the Office Action, claim 33 has been rejected under 35 U.S.C. §102(b) as being anticipated by Lunn (U.S. Patent No. 5,509,910). Applicants respectfully traverse the rejection.

Independent claim 33, as amended, recites:

33. A method of providing a transition region in a guide catheter, the guide catheter including an inner layer and an outer layer, the guide catheter having a distal region, a proximal region and an intervening transition region, the method comprising steps of:

removing a portion of the outer layer such that the inner layer remains where the outer layer was removed; and

replacing the removed portion of the outer layer with a different polymer to form the transition region;

wherein the transition region has a flex modulus that is different from that of the distal region and the proximal region.

Lunn does not teach or suggest such a method. For example Lunn does not teach or suggest removing a portion of the outer layer such that the inner layer remains where the outer layer was removed. MPEP 2131 states, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Lunn teaches a catheter having a soft distal tip connected to the main catheter shaft by a high tensile strength segment. Lunn teaches the catheter 3 is made by first creating two ungular sections in the catheter shaft 3. Similarly, Lunn teaches the soft tip segment 5 is also modified to have two ungular sections. Lunn teaches the soft tip 5 and the catheter 3 are assembled by placing the two components over a steel mandrel with the ungular sections of each component facing one another and separated from each other creating a gap. A material is injected to fill the gap between the catheter shaft and the soft tip. Once the material has solidified, Lunn teaches a device having a catheter shaft, a high tensile strength segment, and a soft distal tip. Nowhere does Lunn teach or suggest removing a portion of the outer layer such that the inner layer remains where the outer layer was removed as currently claimed.

Thus, Lunn cannot be considered as anticipating the claimed method. Further, there is no motivation, suggestion, or other reason for one of ordinary skill in the art to modify Lunn to achieve the method as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

On page 2 of the Office Action, claims 40-48 have been rejected under 35 U.S.C. §102(b) as being anticipated by Noone et al. (U.S. Patent No. 6,591,472). Applicants respectfully traverse the rejection.

As discussed in the telephone interview, the instant application is a continuation of application Serial No. 09/313,672, which has matured into U.S. Patent No. 6,858,024. The '672 application is itself a continuation of application Serial No. 08/800,927, which has matured into U.S. Patent No. 5,911,715. By definition, therefore, the '927 application discloses the same subject matter as the pending application. Thus, the instant application is entitled to a priority date that is at least as far back as the filing date of the '927 application. The '927 application was filed on February 13, 1997. The Examiner has relied upon Noone et al. (U.S. Patent No. 6,591,472) as anticipating the claimed invention. However, Noone et al. was filed on December 8, 1998. As this date is after our priority date, the Noone reference is not available as prior art.

In formulating the rejection, the Examiner has asserted the parent and grandparent applications do not provide clear support for the subject matter in the claims. While Applicants do not concede the correctness of the assertion, independent claim 40 has been amended to more particularly define the invention. Applicants respectfully submit clear support may be found in the '927 application, and thus Noone et al. is not available as prior art.

Claim Rejections under 35 U.S.C. § 103

On page 3 of the Office Action, claims 35, 38, and 39 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lunn (U.S. Patent No. 5,509,910). Applicants respectfully traverse the rejection.

For at least the reasons set forth above, Lunn does not teach each and every element of independent claim 33 from which the above claims depend. The above referenced dependent claims add significant limitations to further distinguish them from the prior art. Further, there is no motivation, suggestion, or other reason for one of ordinary skill in the art to modify Lunn to achieve the method as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Todd A. Berg et al.

By their Attorney,

Date: June 17, 2009

/david m. crompton/

David M. Crompton, Reg. No. 36,772
CROMPTON, SEAGER & TUFTE, LLC
1221 Nicollet Avenue, Suite 800
Minneapolis, MN 55403-2420
Telephone: (612) 677-9050
Facsimile: (612) 359-9349